

REMARKS

Applicants respectfully request entry of the Amendment and reconsideration of the claims. Claims 41, 44, and 49 were amended for clarity and consistency throughout the claims. New claims 50-52 were added. No new matter is added by the amendments or the new claims. Claims 41-42, 44, 46-47, and 49-52 are currently pending. Applicants respectfully request reconsideration and withdrawal of the pending claim objections, obviousness-type double patenting rejections, and rejections under 35 U.S.C. § 112, first paragraph.

Comments Regarding New Claims

New claims 50-52 were added. These new claims do not add new matter. Support for claim 50 can be found throughout the specification, including page 38, line 3 to page 39, line 9. Support for claims 51-52 can be found throughout the specification, including page 31, lines 7-10.

Comments Regarding Claim Objections

The Examiner objects to claim 49 due to the misspelling of "differentiated" and due to the syntax of part (iii) of the claim. Claim 49 has been amended as suggested by the Examiner. Accordingly, Applicants request removal of the pending objections to claim 49.

Comments Regarding the Double Patenting Rejection

The Examiner provisionally rejects claims 41-42 and 44 for obviousness-type double patenting over claims 1, 5, 6, and 18 of U.S. Patent No. 6,235,970. Additionally, the Examiner provisionally rejects claim 49 for obviousness-type double patenting over claims 1-12 and 21 of U.S. Patent No. 6,215,041. The Applicants enclose herewith a Terminal Disclaimer with this Amendment to obviate the double patenting rejection. The Applicants respectfully request withdrawal of the rejection.

Comments Regarding Rejections under 35 U.S.C. §112, first paragraph

The Examiner rejects claim 41 under 35 U.S.C. §112, first paragraph. The Examiner asserts the enablement of the specification is not commensurate with the scope of claim 41 without the limitation of culturing the nuclear transfer (NT) unit until a discernible trophectoderm and inner cell mass (ICM) is obtained. Applicants respectfully traverse.

Applicants respectfully assert that the instant specification enables claim 41 without the specific limitation of obtaining ICM cells from a cultured NT unit with a discernible trophectoderm and ICM. In the rejection, the Examiner cites page 39, line 14-15, which recites

Typically, the cells used to obtain the stem cells or cell colonies will be obtained from the inner most portion of the cultured NT unit... [*emphasis added*]

The above recite morphology is the *typical* structure, not the *only* structure. Applicants do *not* disclose that a discernible trophectoderm and ICM in the NT unit is required to obtain C1CM cells. Rather, the sentence following the Examiner's above citation recites the following:

However, NT units of smaller or greater cell numbers as well as cells from other portions of the NT unit may also be used to obtain ES cells and cell colonies.
Page 39, lines 16-18.

The specification teaches blastocysts at various cell stages and does *not* specify that a *discernible* trophectoderm and ICM must be cultured prior to obtaining a C1CM cell. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

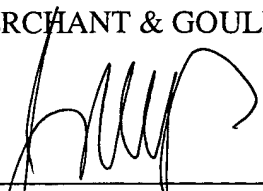
The Examiner rejects claim 49 under 35 U.S.C. §112, first paragraph. The Examiner asserts the enablement of the specification is not commensurate with the scope of claim 49 without the transfer of the activated NT unit into the uterus of a female pig. Claim 49 has been amended for clarity, which should obviate the Examiner's rejection, to recite that the culturing step is optional. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

CONCLUSION

In view of the foregoing, the Applicants believe that all claims as currently pending are in condition for allowance and such action is respectfully requested. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD, PC



Date: July 26, 2004

Joseph M. Bennett-Paris
Reg. No. 47,226
404-954-5044

